

REMARKS

Pursuant to the present amendment, claims 8-9, 15-16 and 35 have been canceled and claim 30 has been amended. Thus, claims 21-24 and 30-34 are pending in the present application. No new matter has been introduced by way of the present amendment. Claims 21-24 stand allowed.

As an initial matter, claims 8-9 and 15-16 have been canceled as they are drawn to a non-elected species. Applicant specifically reserves the right to pursue the subject matter of claims 8-9 and 15-16 in a later filed application should they so desire.

In the Final Office Action, claims 30, 31 and 32 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Fallin (U.S. Patent No. 5, 108,452). Claims 30-32 and 35 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Subba Rao (U.S. Patent Publication No. 2001/0051831). Applicants respectfully traverse the Examiner's rejections.

Pursuant to the present amendment, independent claim 30 has been amended to recite that the femoral head comprises a threaded bore and that the neck has a threaded portion that is threadingly engageable with the threaded bore. Independent claim 30 has been further amended to recite that the spacer engages an end surface of the neck and/or a bottom surface of the bore when the neck is seated within the bore. Support for these amendments can be found in the specification at, for example, page 7, lines 8-23, and the associated drawings.

As thus amended, it is respectfully submitted that independent claim 30, and all claims depending therefrom, are in condition for immediate allowance. Fallin does not even remotely disclose or suggest the invention defined in claim 30. The Examiner identified elements 45, 50 as the "spacer" in Fallin. Those structures are generally conical shaped members with at least one complete open end surface. Importantly, those structures are not adapted to engage at least one of an end surface of the neck and the bottom surface of the bore when the neck is threadingly

coupled to the threaded bore and the neck is seated therein. Of course, if there are two or more spacers positioned in the bore, one of them would engage the end surface of the neck and another spacer would engage the bottom surface of the bore. Moreover, Fallin does not disclose an embodiment where the neck and femoral head are threadingly coupled to one another.

The Subba Rao reference is also believed to be clearly different from the invention set forth in amended independent claim 30. In Subba Rao, the neck 40 does not have a threaded portion. Nor is the neck 40 threadingly engageable with a threaded bore in the femoral head. As understood by the undersigned, the neck 40 in Subba Rao is designed to slidably move within the coupling member 26. A spring element 32 is employed to purportedly absorb shock and vibration encountered in daily life. ¶¶35-37.

As thus understood, it is respectfully submitted that Subba Rao does not anticipate nor render obvious the pending claims. In Subba Rao, the neck is not adapted to be threadingly coupled to the bore in the femoral head. The neck 40 is designed to effectively “float” within the coupling member 26. Moreover, the “spacer” (coupling member 26) identified by the Examiner is not adapted to engage a bottom surface of the bore or an end surface of the neck when the neck is threadingly coupled to the bore and the neck is seated therein. In Subba Rao, it does not appear that any surface of the coupling ever engages the end surface of the neck 40 or the bottom surface of the bore. In Figure 4B, the screw 46 prevents the coupling from engaging the bottom surface of the bore.

Moreover, it is respectfully submitted that any attempt to assert that amended claim 30 would be obvious in view of the prior art would be improper. First, even if Fallin and Subba Rao were combined, that combination of art would still not teach all of the claimed limitations. Thus, such a rejection would be legally improper. Moreover, there is simply no suggestion in the art of record to modify the teachings of Fallin and Subba Rao to arrive at Applicants’ claimed

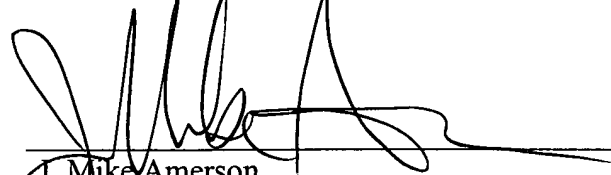
invention. In fact, Subba Rao goes to great lengths to provide relative movement between the neck 40 and the femoral head 24. Claim 30 requires that the neck be threadably engageable with the threaded bore. Thus, modification of Subba Rao such that the neck 40 therein would be threadingly coupled to the head 24 would be contrary to the express teachings of that reference.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. It is respectfully submitted that any attempt to assert that the invention defined by independent claim 1 is obvious in view of the prior art of record constitutes an impermissible use of hindsight using Applicants' disclosure as a roadmap.

In summary, it is believed that claims 21-24 and 30-34 are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "J. Mike Amerson", is written over a horizontal line. The signature is stylized with large loops and a long horizontal stroke extending to the right.

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